

This Page Is Inserted by IFW Operations
and is not a part of the Official Record

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images may include (but are not limited to):

- BLACK BORDERS
- TEXT CUT OFF AT TOP, BOTTOM OR SIDES
- FADED TEXT
- ILLEGIBLE TEXT
- SKEWED/SLANTED IMAGES
- COLORED PHOTOS
- BLACK OR VERY BLACK AND WHITE DARK PHOTOS
- GRAY SCALE DOCUMENTS

IMAGES ARE BEST AVAILABLE COPY.

**As rescanning documents *will not* correct images,
please do not report the images to the
Image Problem Mailbox.**

REMARKS

This Amendment is filed in response to the Office Action dated October 9, 2003. For the following reasons this application should be allowed and the case passed to issue. No new matter is introduced by this amendment. The amendments to claims 4 and 24 are supported by the specification at page 12, lines 3-11. Claim 10, as originally filed, supports the amendment to claims 11 and 12. The amendment to claim 12 is also supported by the specification at page 19, lines 3-9 and FIG. 17. Amended claims 31 and 32 are supported by originally filed claim 30. The amendment to claim 17 is supported by claims 10 and 14, as originally filed. Amended claim 37 is supported by originally filed claims 30 and 34. As acknowledged by the Examiner, the specification supports the amendment to claim 40. Claims 1, 6, 9, 20, 21, 26, 29 are amended to correct minor informalities. The amendments to the specification merely corrects informalities.

Claims 1, 4-9, 11, 12, 17, 18, 20, 21, 24-29, 31, 32, 37, 38, and 40 are pending in this application. Claims 9, 12, 18, 26, 29, 32, and 38 are objected to. Claims 4, 5, 11, 17, 24, 25, 31, 37, and 40 are rejected. Claims 1, 6-9, 20, 21, and 26-29 are allowed. Claims 2, 3, 10, 13-16, 19, 22, 23, 30, 33-36, and 39 are canceled.

Claim Objections

Claims 3, 9, 23, 26, and 29 are objected to because of informalities. This objection is traversed, and reconsideration and withdrawal respectfully requested.

Claims 3 and 23 have been canceled. Claims 9, 26, and 29 have been amended to correct the asserted informality.

Double Patenting

Claims 10, 11, 13-15, 17, 19, 30, 31, 33-35, 37, and 39 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 15, 19, 20 , 21, and 24 of copending Application No. 10/108,421. This rejection is traversed, and reconsideration and withdrawal respectfully requested.

A terminal disclaimer in compliance with 37 C.F.R. § 1.321 has been concurrently filed in a separate paper.

Claim Rejections Under 35 U.S.C. § 112

Claim 40 is rejected under 35 U.S.C. § 112, first paragraph, because the specification is allegedly enabling for joining two electroluminescence light source pieces for use in an image reading apparatus, not for joining any type of light sources. This rejection is traversed, and reconsideration and withdrawal respectfully requested.

Applicants submit that claim 40, as originally filed, is enabled by the instant specification. However, in order to advance the prosecution of this application, claim 40 has been amended in accordance with the Examiner's recommendation to specify that the two light source are electroluminescence light sources.

Claim Rejections Under 35 U.S.C. § 102

Claims 3 and 23 are rejected under 35 U.S.C. § 102(e) as being anticipated by Murakami (U.S.Patent No. 5,483,120). This rejection is traversed, and reconsideration and withdrawal respectfully requested.

Applicant submits that this rejection is moot, as claims 3 and 23 have been canceled.

Claims 4 and 24 are rejected under 35 U.S.C. § 102(e) as being anticipated by Pennaz et al. (U.S. Patent No. 6,624,569). This rejection is traversed, and reconsideration and withdrawal

respectfully requested. The following is a comparison between the claimed invention and the cited prior art.

An aspect of the invention, according to claim 4, is a light source for image reading apparatuses, comprising a transparent substrate and a transparent electrode layer laminated on the transparent substrate. A lead is laminated on a part of a peripheral portion of the transparent electrode layer. An electroluminescence layer is laminated on the transparent electrode layer and the lead. A metallic electrode layer is laminated on the electroluminescence layer.

Another aspect of the invention, according to claim 24, is an image reading apparatus comprising a light source. The light source comprises a transparent substrate and a transparent electrode layer laminated on the transparent substrate. A lead is laminated on a part of a peripheral portion of the transparent electrode layer. An electroluminescence layer is laminated on the transparent electrode layer and the lead. A metallic electrode layer is laminated on the electroluminescence layer.

Pennaz does not anticipate claims 4 and 24 because Pennaz does not disclose a lead laminated on a part of a peripheral portion of the transparent electrode layer and an electroluminescence layer laminated on the transparent electrode and the lead, as required by claims 4 and 24. Pennaz teaches that the electroluminescence layer 4 is laminated on an insulating layer 3, not on a transparent electrode 6 and lead 9, as required by claims 4 and 24.

Claims 4, 5, 10, 14, 16, 19, 24, 25, 30, 34, 36, and 39 are rejected under 35 U.S.C. § 102(e) as being anticipated by Abe et al. (JP 05315073). This rejection is traversed, and reconsideration and withdrawal respectfully requested.

As regards claims 10, 14, 16, 19, 30, 34, 36, and 39, Applicant submits that this rejection is moot, as these claims have been canceled.

Abe does not anticipate claims 4 and 24 because Abe does not disclose a lead laminated on a part of a peripheral portion of the transparent electrode layer and an electroluminescence layer laminated on the transparent electrode, as required by claims 4 and 24. Abe teaches that the electroluminescence layer 4 is laminated on an insulating layer 3, not on a transparent electrode 6, as required by claims 4 and 24.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the disclosure in a single reference of each element of a claimed invention. *Helifix Ltd. v. Blok-Lok Ltd.*, 208 F.3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994); *Hoover Group, Inc. v. Custom Metalcraft, Inc.*, 66 F.3d 399, 36 USPQ2d 1101 (Fed. Cir. 1995); *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051 (Fed. Cir. 1987). Because Pennaz and Abe do not disclose the disclose a lead laminated on a part of a peripheral portion of the transparent electrode layer and an electroluminescence layer laminated on the transparent electrode, as required by claims 4 and 24. Pennaz and Abe do not anticipate claims 4 and 24.

Applicants further submit that Pennaz and Abe do not suggest the claimed light source and image reading apparatus respectively.

Claim Rejections Under 35 U.S.C. § 103

Claims 2, 13, 22, and 33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Abe et al. This rejection is traversed, and reconsideration and withdrawal respectfully requested.

Applicant submits that this rejection is moot, as claims 2, 13, 22, and 33 have been canceled.

Allowable Subject Matter

Claims 1, 6-9, 20, 21, and 26-29 are allowed.

Claims 12, 18, 32, and 38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form.

Applicant gratefully acknowledges the indication of allowable subject matter. Claims 12 and 32 have been placed in independent form in accordance with the Examiner's recommendation. As regards claims 18 and 38, Applicant submits that it is not necessary to place these claims in independent form, as they depend from claims 17 and 37, respectively. Claims 17 and 37 were only rejected under obviousness double patenting. Because a terminal disclaimer has been filed, as explained above, the rejection of claims 17 and 37 have been overcome and claims 18 and 38 are allowable for at least the same reasons, as the independent claims from which they depend.

In light of the above Amendments and Remarks, this application should be allowed and the case passed to issue. If there are any questions regarding these remarks or the application in general, a telephone call to the undersigned would be appreciated to expedite prosecution of the application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY



Bernard P. Codd
Registration No. 46,429

600 13th Street, N.W.
Washington, DC 20005-3096
(202) 756-8000 BPC:BPC
Facsimile: (202) 756-8087
Date: February 9, 2004